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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

AMSBURY, WAYNE P

ART UNIT PAPER NUMBER

2161

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/963,320

Applicant(s)

PARRY, TRAVIS J.

Examiner

Wayne Amsbury

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

CLAIMS 12-36 ARE PENDING

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 22-36 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for the use of the term: *circuitry* in the Disclosure. While it would be understood that the basic engineering of computer systems involves circuitry, its uses in the claims such as:

*identifying whether ... requests ...were individually formulated using circuitry ...*  
is not a description of a processor function or a specialized hardware element or a software means in any context provided by the Disclosure in such a way that one skilled in the art would recognize as conveyed by the Disclosure.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 22-36 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is intended by the use of the term: *circuitry* within the claims. In the interest of compact prosecution, this term is interpreted in the context of a given claim as a means for providing the function it is associated with, such as a search engine.

At least **claims 22-28** contain non-standard English: "*internal of the host site*" appears to be intended to mean the Standard English: "*internal to the host site*". **Claim 24** contains: "*an other*" with the apparent meaning: "*another*". **Claim 31** uses: "configure" when it should use: "configured". Please edit the claims for other similar uses of non-standard English.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley, US 2002/0035611, 21 March 2002, and Broster et al (Broster), US 6,424,968, 23 July 2002.**

Dooley is directed to information networks of websites on the Internet [FIG 3]. Some such websites are host level [0044]. Dooley teaches that search engines may be internal to an information network, and some may be external [0045, lines 1-4].

As to **claim 22**:

*using a host site, accessing a plurality of search requests corresponding to an object accessible using the host site*

The elements of the system of Dooley include programs and data in the form of objects made available for execution and access [0023, lines 6-7]. The environment of Dooley includes a high volume of traffic [0012], which implies a plurality of search requests.

*identifying whether the search requests corresponding to the object were individually formulated using circuitry internal of the host site or circuitry external of the host site;*

*selecting different data regarding the object for different ones of the search requests responsive to identification of respective ones of the search requests being formulated using the circuitry internal of the host site or the circuitry external of the host site; and*

*outputting the selected data externally of the host site after the selecting.*

As noted above, *circuitry* in this context is taken to be a search engine or browser used to generate queries for a search engine, or any other such determination of an access request. Dooley teaches that an internal search engine provides exclusive or enriched information or links to the information with the network's member websites

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[0045]. It is inherently necessary to distinguish between internal or external requests in order to do this.

Dooley is silent as to whether or not enriched information or links comprise a different set of output objects in response to a request, or a different output relative to a specific object. Both interpretations fall within the statement cited.

**Official Notice** is given that it was well known in the art at the time of the invention to provide a different set of results from that provided to another user of the same data set. Broster provides evidence for this as follows:

Broster is directed to an information management system that corresponds to a website with an internal search engine [FIG 1]. Broster recognizes that classes of users differ [COL 2 lines 44-58; COL 3 lines 26-29], that objects have profiles that can be matched with user profiles [COL 4 lines 3-6], and that the results of a query differ depending on the user making a request [COL 2 line 64 to COL 3 line 9].

In the example cited by Broster, a virtual case file of a data set is an object that may be queried by different users and result in distinct output results. This corresponds to a match between user profiles and object profiles.

One of ordinary skill in the art would have recognized that users in the system of Dooley with internal and external access to a website and/or local area network and/or enterprise component may fall into different classes of user with different profiles.

**It would have been obvious** to one of ordinary skill in the art at the time of the invention to recognize that users of an external search engine can receive different results because they comprise a different class of users.

As to **claim 23**, the use of an internal search engine in both Dooley and Broster correspond to formulating a query with a local browser.

As to **claim 24**, Dooley is directed to both internal and external requests.

As to **claim 25**, Dooley is directed to nodes of a network, the Internet in particular.

As to **claim 26**, it is inherent in the meaning of *internal* that an internal search engine is stored at the specified site.

As to **claim 27**, the sites of Dooley may include a database [0046].

As to **claim 28**, the meaning of internal restricts the internal search engine to a specified host, the use of the Internet as an environment allows external engines to search other sites.

As to **claim 21**, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide differing monetary costs for internal and external searches because some external vendors charge a fee to outside searchers [Dooley, 0009, lines 11-16].

The elements of **claims 12-20 and 29-36** are rejected in the analysis above and these claims are rejected on that basis.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 571-272-4015. The examiner can normally be reached on M-F 6-18:30 FIRST WEEK.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPA

  
WAYNE AMSBURY  
PRIMARY PATENT EXAMINER